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In re Application of:

Osborne, Thomas A., et al.

Serial No. 10/642,513

Filed: August 15, 2003

Docket: 8627-183

Title: STENT AND METHOD OF FORMING  
A STENT WITH INTEGRAL BARBS

DECISION ON PETITION  
UNDER 37 CFR § 1.181

This is a decision on the petition filed on December 26, 2006 under 37 CFR § 1.181. Petitioner requests that the finality of the rejection filed on October 10, 2006 be withdrawn as premature.

The petition is dismissed.

Background

The examiner mailed a Final Rejection on October 10, 2006 rejecting claims 45, 46, 48-50, 53, 58 and 60-62 under 35 U.S.C. § 102(e) as anticipated by Chuter. On December 13, 2006 the petitioners filed an Amendment After Final, raising the question of prematurity of the final rejection. On December 26, 2006 the examiner entered an Advisory Action finding that the request for reconsideration did not place the application in condition for allowance. The examiner noted that “although the exact text of the claims are not the same as claims prior to the RCE, the claims as a whole describe the same invention, and the previously applied reference reads on the new claims.” Also on December 26, 2006 the petitioners filed the present petition requesting that the finality of the October 10, 2006 rejection be withdrawn as premature, for the rejected claims were not “drawn to the same invention in the earlier application.”

On January 10, 2007 the applicants entered a second Request for Continuing Examination with the corresponding fees under 37 CFR §1.17(e). The RCE was entered and the applicants were thereby able to amend claims 45 and 58 and provided new arguments for the novelty of the rejected claims. On January 29, 2007 the examiner mailed a Non-Final Rejection of the same claims under 35 U.S.C. §102(b) as being anticipated by Anderson. (These same claims were previously rejected as being anticipated by Chuter.) On April 5, 2007 the applicants filed another amendment, discussing the examiner’s rejections in light of Anderson.

Discussion

The present petition, filed on December 26, 2006 requests the withdrawal of the finality of the Office Action filed on October 10, 2006 as premature with regards to claims 45, 46, 48-50, 53, 58, and 60-62. However, in response to the December 26, 2006 Advisory Action, the applicants filed a Request for Continuing Examination on January 10, 2007.

With respect to a Request for Continuing Examination, 37 CFR §1.114(d) states:

If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered.

A review of the record indicates that the applicants timely filed a submission and paid the fees set forth in §1.17(e). Therefore the Request for Continuing Examination was entered, the finality of the Office Action filed on October 10, 2006 was operatively withdrawn, and the applicants were able to argue the merits of the examiner's rejections in subsequent amendments.

Decision

In view that the contested claims are now pending before the examiner, the petitioners' request for relief is moot. Therefore, the petition to withdraw the finality of the October 10, 2006 Office Action is dismissed as moot.

PETITION DISMISSED.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Programs Examiner, at (571) 272-4514.

for Karen M. Young  
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